

Application No. 09/844,083

Applicant: Oliver Nickel

Response to Notice of Non-Compliant Amendment dated September 17, 2003

REMARKS

In response to the Notice of Non-Compliant Amendment dated September 17, 2003, an amendment which complies with 37 CFR 1.121 is submitted herein. Claims that were previously presented as "Previously Amended" or "Previously Added" are now recited to be "Previously Presented". The comments below are identical to those presented in the amendment filed August 13, 2003 as they relate to the amended claims, and they are presented again here for the Examiner's convenience. Comments made below referring to terminal disclaimers and an information disclosure statement are moot in view of their filings on August 13, 2003 and August 14, 2003, respectively.

Claims 1-20 are pending. Amendments have been made to claims 1, 7, and 11 in response to the 35 U.S.C. 112, second paragraph, rejections found at page 2 of the Office Action. A mark-up showing the changes that have been made to these claims using brackets and underlining is above. It is believed that no new matter has been added.

At the outset, Applicant wishes to point out co-pending application no. 09/844,084. An Information Disclosure Statement will be filed accordingly.

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Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 1-20 under 35 U.S.C. 112, second paragraph, as being indefinite.

The Examiner found no structural relationship between the adhesive composition and the backing. In response, claim 1 has now been amended to show the adhesive composition as being "applied to said backing". The Examiner also found no structural relation between the adhesive tape, the masking material, and the masking sheet. In response, Applicant submit there is indeed a structural relation, wherein the masking material and the masking sheet are "laminated in an edge region of the pressure-sensitive adhesive composition" of the adhesive tape, thereby connecting all three recited elements of claim 1. The Examiner also found no antecedent basis for "an edge region" and "on a side" in claim 1. Applicants point out there is no requirement for antecedent basis here, because they are the first recitations in the claim, wherein neither phrase contains "the" or "said" preceding the claim element. The Examiner queried how an adhesive composition can have an edge region. In response, Applicant submits a person skilled in the art would understand that an adhesive composition is a solid after application to the backing, and it can therefore have an edge region. Claim 7 has been amended in accordance with the Examiner's suggestion. Claim 11 has been amended to cancel the term "fine" for clarity.

For the record, Applicant emphasizes that although the claims were amended to overcome this rejection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims

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were for clarification purposes only, and that Applicant did not narrow the claims in any material respect.

Therefore, Applicant submits that the amended claims are entitled to the full range of equivalents.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Double Patenting Rejections under 35 U.S.C. 101

The Examiner rejected claims 1-3, 5-7, 9, 10, 13-15, 17, and 19-20 under 35 U.S.C. 101 as claiming the same invention as application no. 09/431,849. In response, Applicant points out that the claims must be co-extensive in scope and claiming identical subject matter. *See In re Vogel*, 164 USPQ 619 (CCPA 1970); *See also* MPEP §804 ("II.A. Statutory Double Patenting- 35 U.S.C. 101"). Applicant refers the Examiner to subsection a) of claim 1, which recites the heat resistant adhesive tape comprising a flexible sheet and a pressure-sensitive adhesive composition. The specification, at page 3, last bulleted paragraph, exemplifies the flexible sheet being of "polypropylene and particularly of PVC, soft PVC being preferred". In contrast, application no. 09/431,849 requires a paper backing. Accordingly, the claims are not co-extensive in scope and not claiming identical subject matter.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider

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and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Obviousness-type Double Patenting Rejections

Claims 1-20 are rejected under obviousness-type double patenting in view of application no. 09/431,849. In response, terminal disclaimers over co-pending application no. 09/431,849 and co-pending application no. 09/844,084 will be submitted.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (11 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: September 29, 2003

By 

David D. Kim

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